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EXAMINER

GORDON, BRIAN R

ART UNIT PAPER NUMBER

1743

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,811

Applicant(s)

LEFEBVRE, PAUL M.

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3-28-02 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-12-02, 7-6-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, drawn to a sample injection system, classified in class 422, subclass 100.
 - II. Claim 14, drawn to a liquid chromatograph sample injection system, classified in class 422, subclass 70.
 - III. Claims 15-18, drawn to a sample injection system, classified in class 422, subclass 100.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (II and III) and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of Group II and III do not require the particulars of Group I such as XYZ drive system, sample analyzer, probe pump, etc of Group I. The subcombination has separate utility such as aspirating and dispensing liquids to and from containers or a sample analyzer.
3. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed

does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of Group II does not require the particulars of Group III such as the support, sample analyzer, source of pressurized gas, horizontal and vertically moving drive system, etc. The subcombination has separate utility such as aspirating and dispensing liquids to and from containers or a sample analyzer.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
7. During a telephone conversation with Kathryn E. Cox on December 9, 2004 a provisional election was made with traverse to prosecute the invention of Group II, claim 14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-13 and 15-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Interpretation

8. As to claim 14, it is unclear what exactly applicant is intending to claim. Applicant has elected to refer to the invention as a "liquid chromatography sample injection system". Such an election does not imply any additional structure be interpreted as being included within the claim. Furthermore, the preamble states the device is for use with an automated liquid handler of the type having a probe and a probe drive system for moving the probe. Such a statement is directed to intended use of the structure.

The recitation of "a liquid chromatography sample" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The claim further states, the injector valve is mounted upon the probe drive system that is not positively claimed.

It appears as if applicant is attempting to claim the combination of the drive system and the injector valve. Therefore, the drive system must be positively claimed

as an element of the invention. For the purpose of examination, the examiner has interpreted the claim as such.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Zesiger US 6,743,397.

Zesiger discloses a device for qualifying products containing volatile substances forming an analyte. The device includes a measuring apparatus (2) provided with an enclosure (21a) and an electronic analyzing circuit (21b) for defining said analyte characteristics, a pumping system (30) for producing a vacuum inside said enclosure, a sampling chamber (16) wherein the analyte is introduced and a capillary (22) for connecting said chamber (16) to said enclosure (21a). The invention also has a chamber (16) that includes: a first inlet (18) for introducing the analyte and provided with a sealed plug (27, 60, 62); a second inlet (17) connected to a blow-down gas (11) and provided with a valve (23); and an outlet (19) for evacuating the gas contained in the chamber (16) and likewise provided with a valve (29), and it further has a transfer device (35, 32) for introducing the analyte into the chamber and a programmer (15)

controlling the analyzing circuit (21b), the transfer device (35, 32) (drive system) and the valves (23, 29), and arranged such that the purge of the chamber (16), the enclosure (21a) and the capillary (22) can be carried out automatically (abstract).

The analyte transfer device 34 (probe drive system) comprises a syringe 35 (probe) fitted with a plunger 36 and a needle 37. The syringe 35 also has an inlet 38 fitted with a valve 39 (injection valve) commanded by the programmer 15 and connected with the tubing 12 to the gas source 11 used to purge it. It can also be advantageously heated, by standard means, not represented, to avoid a condensation or an adsorption of some analyte substances (column 4, lines 47-55).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bergh, H. Sam et al.; Smith, Matthew F. et al.; Petro; Miroslav et al.; Miller; Leslie A. et al.; and Sisti; Giorgio et al. disclose injection valves.


While publication US 20020106813 is not considered prior art at this time, the examiner would like to direct applicant's attention to paragraphs [0115] –[0117] which reads on claim 14 as presently drafted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, with 2nd and 4th F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

brg


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